



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,395	02/22/2005	Gunter Kaupp	KAUPPI	7134

1444 7590 09/28/2006

BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

EXAMINER

ABU-ALI, SHUANGYI

ART UNIT	PAPER NUMBER
----------	--------------

1755

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/525,395	KAUPP ET AL.	
	Examiner	Art Unit	
	Shuangyi Abu-Ali	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/22/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

(1)

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/EP2003/008729, filed on 08/21/2002.

(2)

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(1) Regarding claim 1, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

(2) Claims 8-16 and 18 recites the limitation "the metallic core ". There are insufficient antecedent basis for this limitation in the claims.

(3) Claim 6 recites the limitation "the organic material" in lines 2- 3. There is insufficient antecedent basis for this limitation in the claim.

(4) Claim 7 recites the limitation "the encapsulation" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 1755

(3)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8, 16, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,931,996 to Reisser et al.

Regarding applicant claims 1-3 and 20, Reisser et al. disclose a metal pigment, which can be used in cosmetic preparations, comprising an aluminum substrate or core with a dense metal oxide thereon (see abstract). The functions of the layer are to prevent the direct contact between skin and metallic substrate and the reactions between chemicals and metal substrate (col.6, line 64 - col. 7, line1). In order to use the pigments in cosmetic preparations, the layer of the pigment and the binding or carrier of the cosmetic preparation must be compatible with each other.

Regarding applicant claims 4 and 8, Reisser et al. describe that the core of instant invention is aluminum and transition metal oxide such as titanium oxide, iron oxide, aluminum oxide and corresponding hydrates can used as layer material (col. 2, line 6, col. 1, line 54 and col. 2 lines 35-37).

Regarding applicant claim 5, Reisser et al. describe that poly-coated color pigment can be coated on metal surface (col.1 line 66- col. 2 line 5).

Art Unit: 1755

Regarding applicant claim 16, Reisser et al. describe that the preferred percentage of metal oxide layer with respect to the aluminum substrate is from 3% to 95% (col.4, lines 1-5). This range overlaps the weight ratio of the applicant's claim of weight ratio of coating to metallic core between 1 and 0.001.

Regarding applicant claim 19, Reisser et al. describe that the layer of aluminum substrate is produced through sol-gel process by hydrolysis of metal acid esters and vapor depositing of metal acid ester in a water miscible solvent with the assistance of basic catalyst (claims 18 and 26). Alcohols as solvent are recommended, since there is no need to degrease the pigment (claim 19).

(4)

Claims 1,2, 5 -15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,718,753 to Suzuki et al.

Regarding applicant claims 1,2 and 5, Suzuki et al. disclose an invention to produce a metallic pigment that has a transition metal core such as aluminum, bronze, copper, silver, gold and silver (col. 3, lines 1-19) coated with organic materials (claims 1 and 2).

Regarding applicant claims 6 and 7, Suzuki et al. describe that high molecular weight polymers can be used as coating layer such as polyolefin, silicon polymer, and polystyrene (col.12, lines 52-65). The preferred organic layer's thickness is around 0.001-2 μm (claim 3).

Regarding applicant claims 8- 15, Suzuki et al. describe that the transition metal such as aluminum, copper or alloy can be used as metal core (col. 3 lines

Art Unit: 1755

1-19). Suzuki et al. do not mention that there is any impurity in the metals, so we assume the metals are pure, thus it will meet the requirement of applicant's claims 9 to 15's metal purity requirement. Suzuki et al. describe the metal core has a particle size between 0.1 to 1000 μm . The most preferred size is between 1 to 100 μm (coll.3, lines 22-29).

(5)

Claims 1 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,213,618 to Souma et al.

Regarding claim 1 and claim 18, Souma et al. disclose making a titanium oxide-coated metal flake through hydrolyzing organic titanate ester compound (abstract). The metallic core has a diameter in the range from 1 to 100 μm and the thickness is in the range of 0.01 to 20 μm (col. 3 lines 24-32).

(6)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1755

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,931,996 to Reisser et al. in view of PCT patent No. WO 95/14732 to Nadkarni et al.

Reisser et al. disclose an invention about an aluminum pigment, which can be used in cosmetic preparations, contains an aluminum substrate with a dense metal oxide layer (abstract). The functions of the layer are to prevent the

Art Unit: 1755

direct contact between skin and metallic substrate and the reactions between chemicals and metal substrate (col. 6, line 64 - col. 7, line 1).

Reisser et al. fail to teach grinding the metallic pigment using lubricants of plant origin.

Nadkarni et al. teaches that it is "present-day commercial practice" to grind aluminum flake pigment in the presence of a small amount of lubricant such as fatty acid (page1, lines 11-17), which can be extracted from plant leaves.

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the fatty acid lubricant of Nadkarni et al. in the method of Reisser et al. since Nadkarni et al. disclose that such is known and is also a "present- day commercial practice".

(8)

Conclusion

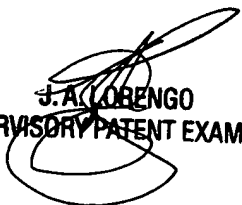
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Such prior art includes references E-H listed on Form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shuangyi Abu-Ali whose telephone number is 5712726453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 5712721233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1755

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



J. A. LORENGO
SUPERVISORY PATENT EXAMINER